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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,401	12/06/2000	Romulo A. Prieto	1-20646	8302

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EXAMINER

STORMER, RUSSELL D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,401

Applicant(s)

PRIETO ET AL.

Examiner

Russell D. Stormer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

Election/Restrictions

1. Applicant's election with traverse of the invention of Group II in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the process as claimed can be used only to make the product as claimed (wheels) and cannot be used to make a materially different product. This argument is found to be persuasive. However, the product as claimed can be made by a materially different process. Original claim 1 recites a curing step which is not required in the product claims. Original claim 2 recites a specific cleaning step which is not required in the original product claims. Further, new claim 25 sets forth specific processes of depositing the first finish layer. Such processes are not required in the product claims and therefore the product can be made by a different process, such as dipping the wheel with the first finish layer.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-10 and 21-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Claim Objections

3. Claim 29 is objected to because of the following informalities: The claim is indefinite because the intermediate layer of aluminum oxide lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 11-14, 16-20, 26, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mokerji in view of Wei.

Mokerji (U.S. Patent No. 6,242,100) discloses a metallic coating comprising a polymeric or resinous first layer 20, a metallic second layer 21 which may include a chromium, and a clear coat top layer 22. The coating may be applied to any article made of aluminum which is desired to be protected, such as a wheel cover, but the use of the material to coat a wheel is not disclosed.

Wei (U.S. Patent 5,632,529) discloses a wheel comprising an aluminum wheel coated with a multi-layer chrome plating to protect and improve the appearance of the wheel. Wei '529 teaches the desirability of coating an aluminum wheel for reasons stated therein. From this teaching, it would have been obvious to apply the coating material of Mokerji to a wheel in order to protect and improve the appearance of the wheel as is well-known in the art.

7. Claims 15 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mokerji '100 in view of Wei '529 as applied to claims 14 and 27 above, and further in view of ZoopSeal FAQ.

The material of Mokerji '100 in view of Wei '529 comprises a clear coat as the third layer, but the third layer does not include a ceramic and clear coat.

In the ZoopSeal FAQ, the clear, ceramic sealer is taught as being usable to coat aluminum wheels. For the top coat clear coat of the material on the wheel of Mokerji '100 in view of Wei '529 to comprise a ceramic and a clear coat would have been obvious as taught by ZoopSeal in order to protect the wheel.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other wheel assemblies and coating materials.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

12/29/03


RUSSELL D. STORMER 12/29/03
PRIMARY EXAMINER